



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/450,923	11/29/1999	JIMMY PIN FAI CHUI	11087/016001	8332

7590 05/15/2002

FISH & RICHARDSON PC
2200 SAND HILL ROAD
SUITE 100
MENLO PARK, CA 94025

EXAMINER

MATHEWS, ALAN A

ART UNIT	PAPER NUMBER
----------	--------------

2851

DATE MAILED: 05/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/450,923

Applicant(s)

CHUI ET AL.

Examiner

Alan A. Mathews

Art Unit

2851

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-70 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 5. 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-70 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-155 of copending Application No. 09/436,704. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-70 in the instant application are obvious modifications of claims 1-155 in copending Application No. 09/436,704.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 11-14, 26-28, 58-61, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 11, lines 1 and 2, there is no proper antecedent basis in the claim for "the sequence number". In claim 12, line 2 and claim 14, lines 2 and 3, there is no proper antecedent basis in each claim for "the offset sequence number". In claim 26, line 2, there is no proper antecedent basis for "the offset sequence number", since "offset" was not recited in claim 15, from which claim 26 depends. In claim 28, lines 2 and 3, there is no proper antecedent basis for "the offset sequence number". In claim 58, line 2, there is no antecedent basis for "the sequence number". In claim 59, line 2, there is no proper antecedent basis for "the offset sequence number". In claim 61, line 3, there is no proper antecedent basis for "the offset sequence number".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2851

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 5-10, and 32-43, 48, 52-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Slater et al (U. S. Patent No. 6,157,435). Slater et al discloses in figures 5 and 8, and column 15, lines 35-67, and column 16, a print or certificate 500 which includes images 501 and 510. Print 500 includes codes 504 and 505 and unique identification codes 511, and 512. Retailer logo 508 and a service provider logo 513 can also be provided. As disclosed in figure 8 and column 16, lines 37-65, this certificate could alternatively be printed on the backside of a printed image of the order. As disclosed in column 17, lines 1-9, the product being ordered could be a printed image (such as enlargements, which would indicate a size). This, in effect, would be print re-ordering. Column 16, lines 23-27 disclose that when the certificate data include a modification of the customer imaged used to obtain the hardcopy image 501, the image composite ID codes 505 and 504 include a reference to the algorithm which made that modification. With respect to claims 48 and 52-57, which are drawn to a computer readable

Art Unit: 2851

medium for carrying out the steps in claims 1 and 5-10, the specification and claims indicate a computer readable medium for carrying out these steps (as just one example, the last two lines of the Abstract and claims 60-64 illustrate claims a computer program product to carry out the methods disclosed).

3. Claim1, 5-10, and 32-43, 48, 52-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Shiota (U. S. Patent No. 6,169,596). Shiota discloses in figure 1 and column 2, lines 13-15, and column 3, lines 42-48, printing an order sheet on the back of each picture print or in a blank space of index prints. Each print order sheet has search ID information on it.

5. Claims 1, 5-10, and 32-43 are rejected under 35 U.S.C. 102(a) as being anticipated by Yamamoto (U. S. Patent No. 5,715,034). Yamamoto discloses in figures 15 and 16 and column 18, lines 61-67, and column 19, and column 20, lines 1-8, an information card affixed on the rear surface on the index print or photo print. A large amount of information is included on the information card including the customer name to order information and the store name 212.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2851

6. Claims 15-31, 44-47, 49-51, and 58-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater et al (U. S. Patent No. 6,157,435) in view of Sheridan (U. S. Patent No. 5,760,917). Slater et al discloses in figures 5 and 8, and column 15, lines 35-67, and column 16, a print or certificate 500 which includes images 501 and 510. Print 500 includes codes 504 and 505 and unique identification codes 511 and 512. Retailer logo 508 and a service provider logo 513 can also be provided. As disclosed in figure 8 and column 16, lines 37-65, this certificate could alternatively be printed on the backside of a printed image of the order. Thus, Slater et al discloses substantially ^{the invention} except for the order specifying a plurality of recipients. Sheridan discloses in figure 2 and column 4, lines 48-67, the desire to share image sets with a plurality of recipients for the well known purpose of increasing the pleasure of viewing the images among friends and relatives or increasing the efficiency of distribution of images in a business environment. Figure 5 in Sheridan discloses a sequence number 108. Sheridan also discloses in column 7, lines 1-25, the use of a bit sum 100 to identify data entry errors. Sheridan et al further discloses the use of "checksum" in column 7, line 66. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide Slater et al with an order specifying a plurality of recipients in view of Sheridan for the purpose of increasing the pleasure of viewing the images among friends and relatives or increasing the efficiency of distribution of images in a business environment. It would also have been obvious at the time the invention was made to a person having ordinary skill in the art to provide Slater et al with data entry error detection in view of Sheridan for the purpose of improving accuracy of the reordering process.

Art Unit: 2851

4. Claims 2-4 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater et al as applied to claim 1 above, and further in view of Dellert et al (U. S. Patent No. 5,926,288, cited in Applicant's PTO-1449). Slater et al discloses the invention claimed except for specifically disclosing embedding error detection characters in the identifier and adding a sequence number. Dellert et al '288 discloses in column 4, lines 61-67 and column 5, lines 1-20 discloses adding a sequence number 108 and discloses having a bit sum 100 to identify data entry errors. Dellert et al further discloses in column 5, line 62, that the bit sum 100 is sometimes referenced as a "checksum". It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the identification information in Slater et al with sequence numbers and error detection characters in the identifier in view of Dellert et al '288 for the purpose of improved accuracy of the reordering process.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slater et al as applied to claim 1 above, and further in view of Garfinkle et al (U. S. Patent No. 6,017,157). Slater et al discloses the invention claimed except for adding an offset to a sequence number. Garfinkle et al discloses in column 8, lines 8-23, using an index print 8a as an interface with each print marked with a different number. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide Slater et al with an offset sequence number in view of Garfinkle et al for the purpose of improved accuracy in the reordering process.

Conclusion

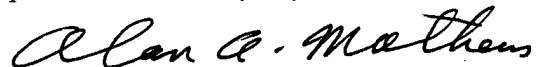
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Ohtsuka, Manico et al, and Nishida et al are cited to show a reorder forms or processes. The patent to Spurr et al is cited to show a digital proof sheet 20 with a memory 24. The patent to Enomoto et al is cited to show back printer 34 which is described in column 5, lines 28-31, and column 7, lines 41-47. The patent to Calhoun is cited to show printing information on the back side of a developed photographic medium. The European Patent Application documents EP 0856972 and EP 0878956 are cited to show network systems for distributing prints.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan A. Mathews whose telephone number is (703) 308-1706. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on (703) 308-2847. The fax phone numbers for the organization where this application or proceeding is assigned are 305-3431 for regular communications and 305-3431 for After Final communications.

Art Unit: 2851

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

A handwritten signature in cursive script that reads "Alan A. Mathews".

Alan A. Mathews
Primary Examiner
Art Unit 2851

AAM
May 13, 2002